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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/647,599	10/03/2000	Leigh T Canham	124-796	1219

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EXAMINER

KISHORE, GOLLAMUDI S

ART UNIT PAPER NUMBER

1615

DATE MAILED: 01/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/647,599

Applicant(s)

CANHAM ET AL.

Examiner

Gollamudi S Kishore, Ph.D

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 154-162 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 154-162 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

In view of applicant's request for a new office action dated 11-22-04, the previous action prosecuting claims 144-153 is vacated.

The following is a new action and the claims included are 154-162.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 154-162 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 97/06101 of record in combination with Cortese (4,608,048), Gopferich (WO 97/32570, English Equivalent, US 6,086,908).

3. WO discloses biomaterial wherein the bioactive porous silicon is impregnated with active agents such as calcium, sodium or phosphorous. The implant device may be a sensor device or a device for intelligent drug delivery (abstract, page 6, lines 5-6). According to WO, bioactive silicon provides the advantage over other bioactive materials in that it is compatible with silicon based integrated circuit technology (page 3, lines 1-2). The porosity is taught on page 13, lines 10-29. Although the porous silicon impregnated with calcium, sodium or phosphorous used in the examples, WO on page 3, lines 23-29 teaches that bioactive silicon could be either microporous (pore diameter 20 Å) or mesoporous (pore diameter 20 Å to 500 Å).

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Although the implant in WO has two specific regions of silicon, the porous region and the bulk region, WO does not specifically teach that the implant could be used for sequential delivery of drugs.

Cortese (4,608,048) while disclosing a drug delivery device containing microporous material teaches that the device can be used to deliver two drugs sequentially (abstract, col. 2, lines 21-35, col. 7, line 47 through col. 8, line 18). Cortese does not teach silicon as the microporous material.

Gopferich while disclosing a sequential drug release device teaches that if the same active compound is administered continuously, tumour cells tend to develop resistances and that implants which release pharmaceutical substances discontinuously or sequentially could counteract this development (col. 1, lines 14-33 of the English equivalent, 6,086,908).

To load a single drug or different drugs in different bioerodable regions of the implant of WO would have been obvious to one of ordinary skill in the art since the references of Cortese, and Gopferich show the routine use in the art and that of Gopferich in particular teaches the advantages of using sequential or discontinuous delivery of a single drug or different drugs.


Alternately, to use bioactive silicon as the porous material in Cortese or Gopferich would have been obvious to one of ordinary skill in the art because of the advantages of silicon over other bioactive material taught by WO 97/06101.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gollamudi S Kishore, Ph.D whose telephone number is (571) 272-0598. The examiner can normally be reached on 6:30 AM- 4 PM, alternate Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K Page can be reached on (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Gollamudi S Kishore, Ph.D
Primary Examiner
Art Unit 1615

GSK